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answers those restatements instead of applicants' actual arguments. Finally, the Examiner's rejections and responses to applicants' arguments are replete with clearly erroneous legal and factual statements and analysis, which will likely require at least a Pre-Appeal Request for Review to advance the prosecution of the case.

Claims 1-2 and 5-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,023,610 (Wood) in view of U.S. Patent No. 4,509,039 (Dowdle). Applicants respectfully traverse this rejection for the following reasons.

Applicants' prior arguments are incorporated herein by reference.

With respect to claim 1, in response to applicants' prior arguments, the Examiner states: "It is inherent to that antennas can function as both transmitting and receiving antennas, and are not limited to just one of these functions or the other." (Emphasis added). This statement is clearly erroneous, both legally and factually. MPEP § 2112 sets forth the legal requirements and burdens of proof that the Examiner must meet to rely on inherency in a rejection. The Examiner fails to meet these legal requirements.

Moreover, the proper test is not whether some antenna, in the abstract, can function as both a transmitting and receiving antenna. In fact, it is irrelevant whether or not any structure 'can' perform any function. The first part of the proper test is what does the reference teach? If the Examiner is relying on inherency, the next part of the proper test is, based on what the reference teaches, the Examiner must prove that "the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (Emphasis added, see MPEP § 2112). Because, the single turn antenna described in the teachings of Dowdle functions only as a receiving antenna, the relied upon characteristic is not inherent (and in fact is contraindicated). Accordingly, the Examiner's reasoning is clearly erroneous and the rejection should be withdrawn.

The Examiner further states that "the size is not a critical element of the antennas." This is clearly erroneous. Dowdle teaches that the interrogation zone must be

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large enough to detect the electronic tags as they pass by. In fact, Dowdle states that it is of "[p]articular importance to the present invention, one type of such systems utilizes a radio frequency energy which is radiated into an interrogation zone along which articles having an electrically resonant circuit secured thereto must pass." See Dowdle, col. 1, lines 16-20. The size of the antennas creates the interrogation zone, which is of 'particular importance' to the invention described in Dowdle.

Because Dowdle fails to make up for the admittedly missing teaching from Wood, and because one of ordinary skill in the art would not be motivated to modify Wood with the antennas of Dowdle, claim 1 is patentable over Wood in view of Dowdle. Dependent claims 2 and 5-8 are likewise patentable.

With respect to claim 2, the Examiner fails to answer applicants' traversal. Namely, the Examiner does not rebut and apparently concedes that Woods fails to teach that there is any period or regularity with which the two antennas X1 and X2 are activated. The newly cited portion, which describes how long attempts to establish communication take, fails to teach or suggest any periodic multiplexing. Accordingly, the rejection of claim 2 fails and claim 2 is separately patentable over Wood in view of Dowdle.

Claims 9-11, 18, 19, 22, 23, 25, and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of U.S. Patent Publication No. US 2003/0122655 (Hum). Applicants respectfully traverse this rejection for the following reasons.

Applicants' prior arguments are incorporated herein by reference.

With respect to claims 9 and 22, in response to applicants' prior arguments, the Examiner again commits clear error in stating: "The transponder 16 in Wood and communication device 12 is part of badge 13, which can be incorporated in or used as a toy." (Emphasis added). Again, it is simply irrelevant that some structure described in

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the reference 'can' be used in some way. Again, the proper test is what does the reference teach? The Examiner's improper analysis is clear legal error.

The Examiner commits further clear legal error in arguing that "Toys fall under moving or stationary inanimate objects." Although Wood describes a genus (moving or stationary inanimate objects), Wood does not teach or suggest the claimed species (toys). It is well settled law that the disclosure of a genus is not effective to anticipate a later described species, and the Examiner's analysis is clear legal error.

Moreover, the Examiner fails to answer the substance of applicants' traversals. Namely, the Examiner fails to explain how one of ordinary skill in the art, having before them only the Wood and Hum references, would be motivated to construct a toy set including a toy figurine and a play device. In response to applicant's arguments, the Examiner apparently withdraws his misplaced reliance on Hum (for allegedly teaching 'a transponder, which can be attached to a toy'). However, the Examiner fails to withdraw the rejection of record or make a new rejection of these claims. Because the Hum reference is critical to the Examiner's prima facie case in the rejection of record, the rejection of record is now admittedly deficient and should be withdrawn.

Because the office action fails to establish a prima facie case of obviousness and because one of ordinary skill in the art would not be motivated to combine Wood and Hum in the manner asserted in the office action, claims 9 and 22 are patentable over Wood in view of Hum. Claims 10-11 depend from claim 9 and are likewise patentable. Claims 23, 25, and 26 depend from claim 22 and are likewise patentable.

Claim 26 recites multiplexing the antenna drive signal is performed periodically. For at least the reasons given above with respect to claim 2, the cited portion of Woods does not teach periodically multiplexing the antennas X1 and X2. Accordingly, claim 26 is separately patentable.

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With respect to claim 18, applicants previously pointed out that the Examiner completely failed to address this claim. Instead of remedying this problem with a new non-final office action, the Examiner unnecessarily protracts the prosecution of the present application by failing to address this oversight. The Examiner responds: "Looking up the location of the antenna that received the return signal is the same as looking up the location of the transponder, which is taught by Hum et al., as explained in the rejection."

This is clear legal error. First, nowhere in the rejection does the Examiner explain how Hum allegedly teaches "looking up the location of the transponder." The pertinent part of the rejection is reproduced below in its entirety:

"Wood, Jr. fails to disclose a program adapted to determine a location of the toy figurine on a play device. Hum et al. disclose a short-range communication system in which a position of a transponder, which can be attached to a toy, is communicated in response to an interrogation signal (paragraph [0013], lines 17-22.)"

As is readily apparent from the foregoing, the Examiner does not explain how Hum allegedly teaches anything involving 'looking up'. Second, the Examiner does not properly interpret the claims. The Examiner should appreciate that 'looking up' is different from 'determining'. The cited portion of Hum does not describe any type of 'looking up'. In fact, the word 'look' does not appear in the text of the Hum reference. It is unfortunate and extremely prejudicial to applicants that the applicants may have to go through the time and expense of obtaining a pre-appeal review or even appeal to correct this clear error.

Because the office action fails to establish a prima facie case of obviousness with respect to claim 18, claim 18 is patentable over Wood in view of Hum. Dependent claim 19 is likewise patentable.

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Claims 13, 14, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of U.S. Patent No. 4,691,202 (Denne). Applicants respectfully traverse this rejection for the following reasons.

Applicants' prior arguments are incorporated herein by reference.

With respect to claim 13, the Examiner continues to commit legal error in his analysis by what asserting what 'can' be done with various structures described in Wood and Denne. The Examiner repeats his erroneous analysis that the badge in Wood 'can' be used as a toy. The Examiner admits that Denne does not relate to toys, but asserts that 'the transponders of Denne can be incorporated in the toy-badges of Wood.' (Emphasis added). Again, it is simply irrelevant that some structure described in the reference 'can' be used in some way. Again, the proper test is what does the reference teach? The Examiner's improper analysis is clear legal error.

Moreover, the Examiner fails to answer the substance of applicants' traversals. Namely, the Examiner fails to explain how one of ordinary skill in the art, having before them only the Wood and Denne references, would be motivated to construct a toy set including toys to be placed on a play device. The Examiner does not rebut and apparently concedes that Wood does not teach or suggest having multiple devices 12 in a single housing 20. The Examiner does not rebut and apparently concedes that Wood teaches away from doing so because each device 12 must be uniquely associated with its housing (e.g. an ID badge).

The Examiner further states that 'one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references,' followed by various citations. The Examiner misconstrues the law and the relevance of the cited cases. These cases stand for the proposition that where the claims are directed to elements A and B, and the rejection relies on the combination of reference X for element A and reference Y for element B (presumably together with a proper motivation to combine), then one cannot show nonobviousness by arguing that reference X does not

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teach element B and reference Y does not teach element A. However, it is a fundamental tenet of the law of obviousness that in order to establish a *prima facie* case of obviousness all of the claim recitations must be taught or suggested by the references. MPEP § 706.02(j) sets forth the required contents of a § 103 rejection, stating in pertinent part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (Emphasis added).

Accordingly, if some claim limitation is not found in any of the cited references, individually, then it is impossible to establish a *prima facie* case of obviousness using any combination of those references. In other words, where the claims are directed to elements A and B, and the rejection relies on the combination of reference X for element A and reference Y for element B (presumably together with a proper motivation to combine), then one can show nonobviousness by attacking the references individually. Namely, by arguing that reference X does not teach element A and reference Y does not teach element A. Without a teaching of element A in any individual reference, the *prima facie* case is not established.

Because neither Wood nor Denne, individually or in combination teach or suggest the recited play device, first toy to be placed on the play device, or second toy to be placed on the play device, and because one of ordinary skill in the art would not be motivated to modify Wood with the teaching of Denne as asserted in the office action, claim 13 is patentable over Wood in view of Denne. Dependent claims 14 and 17 are likewise patentable.

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Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Denne and further in view of Hum. Applicants respectfully traverse this rejection for the following reasons.

Applicants' prior arguments are incorporated herein by reference.

With respect to claims 15 and 16, applicants previously pointed out that the Examiner completely failed to address this claim. Instead of remedying this problem with a new non-final office action, the Examiner unnecessarily protracts the prosecution of the present application by failing to address this oversight. The Examiner responds: "The location of a toy figurine is addressed in the rejection of claim 9, which is referenced in the rejection of claims 15 and 16. Moreover, it is inherent that transponders can have different response characteristics for different applications."

This is clear legal error. First, as previously pointed out claims 15 and 16 include recitations which go beyond 'the location of a toy figurine.' The Examiner is derelict in his duties by failing to address each and every claim recitation. Second, the Examiner continues to fail to meet any of the requirements or burdens of proof to support a rejection relying on inherency. Third, again it is irrelevant that some structure, in the abstract, 'can' have some characteristics. Again, the proper test is what does the reference teach? Again, if the Examiner is relying on inherency, the next part of the proper test is, based on what the reference teaches, the Examiner must prove that "the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (Emphasis added, see MPEP § 2112).

It is unfortunate and extremely prejudicial to applicants that the applicants may have to go through the time and expense of obtaining a pre-appeal review or even appeal to correct this clear error.

In view of the foregoing, favorable reconsideration and withdrawal of the rejections is respectfully requested. Early notification of the same is earnestly solicited.

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If there are any questions regarding the present application, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

November 10, 2005

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